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hereby certify that this correspondence is being deposited with the United States Postal vice with sufficient postage as First Class Mail in an envelope addressed to: COMMISSIONER PATENTS AND TRADEMARKS, WASHINGTON, D.C., 20231, on:

Date: 15 August 1999

Ву:\_\_\_\_\_\_

Docket No. 8600-0146

#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Christopher H. Contag, et al.

Serial No. 08/270,631

Filed: July 1, 1994

For: Non-Invasive Localization of

a Light-Emitting Conjugate

in a Mammal

Examiner: Unknown

Art Unit: Unknown

Attention:

Application Branch

RECLIVED

SEP 1 2 1994

Response to Notice to File Missing Parts of Application

Commissioner of Patents and Trademarks Washington, D.C. 20231

sir:

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In response to the Office action mailed August 1, 1994 (copy attached), applicant hereby submits a Declaration of inventorship, an Assignment for recordation, a Power of Attorney and Exclusion of Inventor(s) of the assignee, and a Verified Statement Claiming Small Entity Status of the assignee of the above-captioned application. Also enclosed is counsel's check for \$534.00 in payment of the basic filing fee (\$355.00 + 74.00 in additional claim fees), the surcharge for late filing of declaration or oath (\$65.00), plus the fee (\$40.00) for recording the enclosed Assignment.

Please charge any underpayment (or credit any overpayment) of fees to Deposit Account No. 04-0531. A duplicate copy of this Response is attached.

Date: 15 Hugur 1994

Respectfully submitted,

Charles K. Sholtz

Registration No. P38,615

Correspondence Address:

Dehlinger & Associates

P.O. Box 60850

Palo Alto, California 94306

(415) 324-0880

## Patent Application Declaration and Power of Attorney.

I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated next to my name in PART A on page 2 hereof.

I believe I am the original, first, and sole inventor (if only one name is listed) or an original, first and joint inventor (if plural names are listed) of the subject matter which is claimed and for which a patent is sought on the invention entitled

#### Non-Invasive Localization of a Light-Emitting Conjugate in a Mammal

the specification of which:

[ ] is attached hereto.

[/] was filed <u>July 1, 1994</u> as Attorney Docket No. <u>8600-0146</u>.

[/] was filed July 1, 1994 as Application Serial No. 08/270,631.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed in PART B on page 2 hereof and have also identified in PART B on page 2 hereof any foreign application for patent or inventor's certificate having a filing date before that of the application of which priority is claimed.

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed in PART C on page 2 hereof and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following as my attorney or agent with full power of substitution to prosecute this application and transact all business in the United States Patent and Trademark Office connected therewith:

Peter J. Dehlinger
Gary R. Fabian
Vincent M. Powers
Charles K. Sholtz
Susan T. Evans
Judy M. Mohr
Reg. No. 28,006
Reg. No. 33,875
Reg. No. 36,246
Reg. No. P38,615
Reg. No. P38,443
Reg. No. P38,563

whose mailing address for this application is: <u>Dehlinger & Associates</u>
P.O. Box 60850
Palo Alto, CA 94306

See Page 2 attached, signed, and made a part hereof.

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# Patent Application Declaration and Power of Attorney

PART A: <u>Inventor Information and</u>	Signat	ure				1	
				1 35	se, 44 hs		in De
Full name of SOLE or FIRST invento	or <u>Chri</u>	stopher H. (	Contag	1-00	14.63	- 45	<u>* {}</u>
Citizenship <u>U.S.A.</u> Post	Offic	e Address <u>20</u>	017 Cali	ifornia Stre	eet #5B	ا جمع المنظم المنظم المنظم المنظم المنظ	
•		_		tain View, (			040
Residence (if different) (same)				CA	4		
Inventor's Signature:	nell	Ba		Dat	:e: <u>\$/</u>	IntoA	
inventor's signature	y of as	7			<u></u>	<i>V/7-</i> 4	
ŕ					_		
Full name of SECOND joint inventor	, if a	ny <u>Pamela R</u>	Contac	2-05			
Citizenship <u>U.S.A.</u> Post	Offic	e Address <u>20</u>	17 Cali	- ifornia Stre	et #5B		
				ain View, C		nia 94	040
Residence (if different) (same)		•			A		
Second Inventor's Signature:	mill	no Pull	1. (2)	nta Dat	e: 8	110/9	74
man.	- pu		1	7		<del>/                                    </del>	
				- 37			
Ful name of THIRD joint inventor,	if any	David A. E	enaron	3-00	·		
Citizenship <u>U.S.A.</u> Post	Office	Address 45	4 Birch	Street			
in the second se			Redwo	ood City, Ca	liforni	<u>a 940</u>	62
Residence (if different) (same)	$A_{-}$		7	<u>CA</u>			<u></u>
Third Inventor's Signature:	M.			Dat	e: <u> </u>	11/9	4
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	* * *	* * * * *	* *				
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PART. B: Prior Foreign Application	<u>(s)</u>						
Serial No. Country	Day/N	Nonth/Year F	iled	Prio	rity Cl	aimed	
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PART C: Claim for Benefit of Fili	ng Date	of Earlier	U.S. A	pplication(	s)		
Serial No. Filing Date	Statu	s:					
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See Page 1 to which this is attached and from which this Page 2 continues.

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t this correspondence is being deposited with the United States Postal Service with I hereby certify sufficient postage as First Class Mail in an Envelope addressed to: Commissioner of Patents and Trademarks,

Vashington, D.C., 20231, on:

15 Auxur 1994 Date:

8600-0146

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re application of

Christopher H. Contag, et al.

Serial No. 08/270,631

Filed: July 1, 1994

For: Non-Invasive Localization of

A LIGHT-EMITTING CONJUGATE

IN A MAMMAL

Unknown Examiner:

Art Unit: Unknown

## Power of Attorney by Assignee and Exclusion of Inventor(s) Under Rule 32

Hon. Commissioner of Patents and Trademarks Washington, D.C. 20231

Dear Sir:

The undersigned assignee of the entire interest in the above-referenced subject application by virtue of assignment recorded concurrently hereby appoints PETER J. DEHLINGER, Reg. No. 28,006; GARY R. FABIAN, Reg. No. 33,875; CAROL A. STRATFORD, Reg. No. 34,444; VINCENT M. POWERS, Reg. No. 36,246; CHARLES K. SHOLTZ, Reg. No. P38,615; JUDY M. MOHR, Reg. No. P38,563; and SUSAN  $ilde{\mathbb{R}}_{2}^{-1}$  T. EVANS, Reg. No. P38,443 as its attorneys/agents to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected herewith, said appointment to be the exclusion of the inventor(s) and their attorney(s) in accordance with the provisions of Rule 32 of the Patent Office Rules of Practice.

Assignee hereby declares that, to the best of its knowledge and belief, title is in the assignee herein, and affirms review of the evidentiary document (of record, above identified) relied upon to establish such ownership.

Please direct all telephone calls to (415) 324-0880 and all correspondence relative to said application to the following address:

> Dehlinger & Associates P.O. Box 60850 Palo Alto, California 94306

I have reviewed the Assignment document concurrently submitted and believe that the above-referenced application has been assigned to assignee herein and that assignee therefore has the right to make this Power of Attorney and Exclusion of Inventor(s); I am duly authorized to sign this instrument on behalf of assignee corporation.

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### page 2

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

> ASSIGNEE: THE BOARD OF TRUSTEES OF THE LELAND STANFORD JR.

> > University

Typed Name: Katharine Ku

Title: Director, Technology Licensing

Stanford University Address:

Office of Technology Licensing 900 Welch Road, Suite 350 Palo Alto, CA 94304

Attorney Docket No.: 8600-0146

Applicant: Christopher H. Contag, et al.

<u>Serial No.</u>: 08/270,631 <u>Filing Date</u>: July 1, 1994

For: Non-Invasive Localization of a Light-

EMITTING CONJUGATE IN A MAMMAL

# <u>Verified Statement (Declaration) Claiming Small Entity Status</u> (37 CFR §1.9(f) and §1.27(c) - Nonprofit Organization

I hereby declare that I am an official empowered to act on behalf of the nonprofit organization identified below:

Name of Organization: The Board of Trustees of the Leland Stanford

Junior University

Address of Organization: Office of Technology Licensing, 900 Welch

Road, Suite 350, Palo Alto, California, 94304

		University or other institution of higher education.					
:0.		Tax exempt under Internal Revenue Service Code (26 USC §501(a) and §501(c)(3)).					
		Nonprofit scientific or education under statute of state of the United States of America.					
Tan Harris		o o	Name of State:				
and the state			Citation of Statute:				
Street transp		Would qualify as tax-exempt under Internal Revenue Service Code (26 USC §501(a) and §501(c)(3)) if located in The United States of America.					
- Tari	□	Would qualify as nonprofit scientific or educational under statute of state of The United States of America if located in The United States of America.					
, Har			Name of State:				
; #			Citation of Statute:				
	a nong	profit	clare that the nonprofit organization identified above qualifies as organization as defined in 37 CFR 1.9 (e), for purposes of paying under section 41(a) and (b) of Title 35, United States Code, with				

the specification filed herewith.

and David A. Benaron described in:

Application Serial No. 08/270,631, filed July 7, 1994.

regard to the invention entitled <u>Non-Invasive Localization of a Light-Emitting</u>
<u>Conjugate in a Mammal</u> by inventor(s) <u>Christopher H. Contag, Pamela R. Contag,</u>

Patent No. \_\_\_\_\_, issued \_\_\_\_\_.

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights to the invention is listed below\* and no rights to the invention are held by any person, other than the inventor, who could not qualify as a small business concern under 37 CFR §1.9 (d) or by any concern which would not qualify as an independent inventor under 37 CFR §1.9 (c) if that person made the invention, or by any concern which would not qualify as a small business concern under 37 CFR §1.9 (d) or a nonprofit organization under 37 CFR §1.9 (e).

\* NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR §1.27).

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Name:						
Address:			13.0054			
	□ individual	□ small business concern	nonprofit organization			
Name:			and the second s			
Address:						
	□ individual	□ small business concern	□ nonprofit organization			

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate (37 CFR §1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such wilful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

☐ Name	of	person	signing:	Mary K. Albertson	
Title	of	person	signing:	Associate	_
				Office of Technology Licensing, 900 Welch, Palo Alt	م:

Signature: Mary K. alberton Date: August 12, 1994

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processing fee is required for returned checks. (37 CFR 1.21(m)). already been paid. translation of the application and a fee of \$\_\_ \_under 37 CFR L.17(k), unless this fee has  $7.\ \Box$  The applicant must filed in a language other than English. Applicant must file a verified English Date, is required. the omitted inventor(s), identifying this application by the above Application Number and Filing An oath or declaration listing the names of all inventors and signed by 6.  $\Box$  The signature of the following joint inventor(s) is missing from the oath or declaration: Number and Filing Date, is required. declaration in compliance with 37 CFR 1.63, identifying the application by the above Application The signature to the oath or declaration ies smissing; ar reproduction; by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or Filing Date, is required. in compliance with 37 CFR 1.63, identifying the application by the above Application Number and 4. 🗆 The oath or declaration does not identify the application to which it applies. An oath or declaration Application Number and Filing Date is required. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above  $\square$  does not cover items omitted at time of execution. .gaissim si 🗆 3. 

The oath or declaration: -fees or cancel-the additional claims for which fees-are due. required multiple dependent claim fee, are required. Applicant must submit the additional claim 2. Additional claim fees of \$ 14.8 as a large entity, 🗆 small entity, including any I. The statutory basic filing fee is: missing \( \text{missing} \) insufficient. Applicant as sell arge entity \( \text{missing} \) sentity, must submit \( \frac{\partial}{2} \) extension fee under the provisions of 37 CFR 1.136(a). required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the FILING DATE of this application, WHICHEVER IS LATER, within which to file all required items and pay any fees Applicant is given ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE entity, 🗆 small entity (verified statement filed), is \$\_ If all required items on this form are filed within the period set below, the total amount owed by applicant as a for small entities who have filed a verified statement claiming such status. The surcharge is set forth in below are missing. The required items and fees identified below must be timely submitted ALONG WITH THE PAYMENT OF A SURCHARGE for items 1 and 3-6 only of \$ / ? Or large entities or An Application Number and Filing Date have been assigned to this application. However, the items indicated EITING DYLE GRYNLED NOTICE TO FILE MISSING PARTS OF APPLICATION :DATE MAILED: F6/T0/80 0000 PALO ALTO, CA 94306 02803 x08 .0.9 DEHLINGER & ASSOCIATES 1080/1**9**80: 169\*075/80 DATMOO \$6/TO/LO Э 97100098 FILING DATE REPLICATION NUMBER FIRST NAMED APPLICANT TTY, DOCKET NOJITLE orer sossi **b**661

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The application does not comply with the Sequence Rules. See attached Notice to Comply with

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Application Processing

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-s A copy of this notice MUST be returned with the response.

9.  $\square$  Your filing receipt was mailed in error because check was returned without payment.

Division, Special Processing and Correspondence Branch (103)-508-1202.

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